

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

*Ex parte* RONALD S. STEELMAN,  
ERIC J. HANSON and JENNIFER JEANNETTE

---

Appeal No. 1997-3887  
Application 08/449,204

---

ON BRIEF

---

Before WARREN, WALTZ and JEFFREY T. SMITH *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

*Decision on Appeal and Opinion*

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing view of the examiner, in the answer, and appellants, in the brief, and based on our review, find that we cannot sustain any of the five grounds of rejection of appealed claims 6 through 11<sup>1</sup> advanced by the examiner on appeal.

We find that the plain language of appealed claim 6, the sole independent claim, clearly specifies that the electrostatic toner receptor layer comprises at least a blend of an acrylic resin, a vinyl resin, a

---

<sup>1</sup> These are all of the claims in the application. See the specification, pages 12-13, and the amendment of August 19, 1996 (Paper No. 4).

solution or dispersion grade rubber and a plasticizer, *see Exxon Chemical Patents Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 1555, 35 USPQ2d 1801, 1802 (Fed. Cir. 1995) (“The claimed composition is defined as comprising - meaning containing at least - five specific ingredients.”), and is adhered to one surface of a “crack resistant” film, wherein the term “crack resistant” is defined in the specification (page 3, lines 12-14). *See generally, In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

With respect to the two grounds of rejection of appealed claims 6 and 9 under 35 U.S.C. § 102(b) over Akiyama et al. (Akiyama) and over Namiki et al. (Namiki) (answer, pages 4-5 and 8-9), the examiner has the burden of making out a *prima facie* case of anticipation in the first instance by pointing out where each and every element of the claimed invention, arranged as required by the claims, are found in each of the references, either expressly or under the principles of inherency. *See generally, In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). This the examiner has not done. We fail to find in Akiyama the disclosure of a “crack resistant” film as this term is used in the appealed claims and the examiner has not explained how the teaching of “a plastic film” (col. 4, line 62) would inherently disclose the specified film. Thus, the examiner has failed to make out a *prima facie* case of anticipation on this basis alone.

We further fail to find in this reference a “blend” comprising at least the four ingredients as specified in claim 6 and indeed, it is not clear from this disclosure that Akiyama even discloses an example of each of the ingredients (e.g., col. 1, line 55, to col. 2, line 23; col. 2, line 64, to col. 3, line 59; Akiyama claim 1). For example, the examiner has not explained why a copolymer of vinyl and acrylate monomers satisfies the requirement for “an acrylic resin” and “a vinyl resin,” and why the copolymer of Akiyama Example 17, which contains a preponderance of styrene, constitutes a “dispersion grade rubber.” Even if each of the elements of the “blend” as claimed could be generated from the disclosure of the reference, we find that one of ordinary skill in this art would have to make judicious selections in type and amount of the large number of listed monomers to form such copolymers and added other components with no disclosed template to follow in order to arrive at the combination of ingredients comprising the claimed “blend.” Indeed, “plasticizers” are listed as one of a large number

of optional additives (col. 4, lines 47-57) and there is no Example or other listing of ingredients for an electrostatic layer which comprises the ingredients of the claimed blend.

We find that Namiki discloses an extensive list of a large variety of polymers having a particular softening point, including reference to such as described in the *Plastics Performance Handbook*, in which one of ordinary skill in this art can identify polymers that satisfy the first three ingredients specified for the “blend” in claim 6, and would find that “[i]t is also possible to add various plasticizers” for the other “blend” ingredient (col. 3, line 67, to col. 4, line 44). It is clear, however, that one of ordinary skill in this art would have to make judicious selections from among the extensive listing of polymers and include the optional plasticizer, without the aid of a template taught in the reference (cf., e.g., col. 4, lines 16-22) in order to arrive at the combination of ingredients in the claimed “blend.”

Based on these teachings of Akiyama, assuming that a “crack resistant” film is disclosed, and of Namiki, we are of the opinion that neither reference *prima facie* provides a description of the claimed graphic article of claims 6 and 9 in the absence of judicious selection, and thus each of the references fail to *describe* the claimed invention within the meaning of § 102(b). *See In re Sivaramakrishnan*, 673 F.2d 1383, 213 USPQ 441 (CCPA 1982) (“[T]he fact remains that one of ordinary skill informed by the teachings of [the reference] would not have had to choose judiciously from a genus of possible combinations of resin and salt to obtain the very subject matter to which appellant’s composition per se claims are directed.”); *In re Arkley*, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972) (“[F]or the instant rejection under 35 U.S.C. 102(e) to have been proper, the . . . reference must clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without *any* need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference. Such picking and choosing may be entirely proper in the making of a 103, obviousness rejection, where the applicant must be afforded an opportunity to rebut with objective evidence any inference of obviousness which may arise from the *similarity* of the subject matter which he claims to the prior art, but it has no place in the making of a 102, anticipation rejection.”)

With respect to the grounds of rejection of claims 7, 8, 10 and 11 under 35 U.S.C § 103 based on Akiyama (answer, pages 6-7 and 10-11), it is well settled that a *prima facie* case of obviousness is

established by showing that some objective teaching, suggestion or motivation in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in the art would have led that person to the claimed invention as a whole, including each and every limitation of the claims, without recourse to the teachings in appellants' disclosure. *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *In re Oetiker*, 977 F.2d 1443, 1447-48, 24 USPQ2d 1443, 1446-47 (Fed. Cir. 1992) (Nies, J., concurring); *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). We agree with appellants that the examiner has failed to carry the burden of making out a *prima facie* case of obviousness with respect to the claimed invention encompassed by these appealed claims.

The examiner has relied on the teachings of Akiyama as discussed in the answer with respect to the ground of rejection under § 102(b), in each of the three grounds of rejection under § 103. We found above in comparing the claimed invention encompassed by claim 6, on which each of the claims considered here directly or ultimately depend, with the teachings of Akiyama that the examiner has not explained how this reference discloses a "crack resistant" film and the ingredients specified for the claimed "blend." Thus, the examiner has not presented on the record an explanation which establishes that one of ordinary skill in this art would have *prima facie* arrived at the claimed invention of claim 6 following the teachings of Akiyama. We find no disclosure in Suzuki et al. (Suzuki) (claim 7) or in Mammino (claims 10 and 11) which combined with Akiyama would have led this person to the claimed invention of claim 6. Thus, without a teaching of the "blend" and "crack resistant" film specified in claim 6 in the prior art, there is no need to consider the other teachings of these references on which the examiner relies. With respect to claim 8, the examiner finds that one of ordinary skill in this art would have employed the terpolymer specified in this claim 8 because "it would have been within the general skill of a worker in the art at the time of the invention to determine suitable polymers for use in the image receiving layer within the guidelines of the prior art" without any explanation of why this is so. Thus, it is clear that in these three grounds of rejection, the examiner has improperly indulged in hindsight by

relying on appellants' invention in reaching the conclusion that the invention encompassed by claims 7, 8, 10 and 11, all dependent directly or ultimately on claim 6, would have been obvious to one of ordinary skill in this art in view of Suzuki, of Mammino, and the "prior art." *See Rouffet, supra* ("hindsight" is inferred when the specific understanding or principle within the knowledge of one of ordinary skill in the art leading to the modification of the prior art in order to arrive at appellant's claimed invention has not been explained); *Dow Chem.*, 837 F.2d at 473, 5 USPQ2d at 1531-32 ("The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. [Citations omitted.] Both the suggestion and the expectation of success must be founded in the prior art, not in applicant's disclosure." ). Thus, we reverse these grounds of rejection.

The examiner's decision is reversed.

*Reversed*

CHARLES F. WARREN  
Administrative Patent Judge

THOMAS A. WALTZ  
Administrative Patent Judge

JEFFREY T. SMITH  
Administrative Patent Judge

)  
)  
)  
)  
)  
) BOARD OF PATENT  
) APPEALS AND  
) INTERFERENCES  
)  
)  
)  
)  
)

Appeal No. 1997-3887  
Application 08/449,204

P.O. Box 33427  
St. Paul, MN 55133-3427